

IV. REMARKS

1. The specification is amended to correct some inconsistencies between the text and the drawings. Applicant appreciates the Examiner's indication of the allowance of claim 15. Claims 16-53 are new.

2. Claims 1, 2, 4, 7, 12, and 13 are not anticipated by Lee et al. ("Lee") under 35 U.S.C. §102(b).

Claim 1 recites establishing the second call between the first network and the mobile station via the second network.. This is not disclosed or suggested by Lee.

Lee discloses a method and system for performing intersystem soft-handoff. The soft-handoff occurs when a subscriber unit crosses from a first cellular system to a second cellular system and involves routing a connection to a target base station controller via an anchor base station controller (see e.g. figures 2A to D). In Lee, Both the first and the second systems are CDMA cellular systems that are capable of performing soft-handoff (see e.g. column 5, lines 13 to 16). The soft-handoff is achieved by establishing a traffic channel between the subscriber unit and a base station of the second cellular system (see e.g. column 15, lines 16 to 51).

Applicant's invention on the other hand is concerned with handing over a connection from a "new" network to an "old" network without having to modify the old network to allow it to support inter-network handover (see e.g. page 2, paragraph 3 of the present application). According to embodiments of the present invention, handover from a first network to a second network is achieved by setting up an additional call between the mobile

station and the first network, via the second network. Data communications between the mobile station and the first network is then transferred from the original call to the new call. The original call is released.

In Applicant's invention, claim 1 is directed towards a method for performing handover of a mobile station communicating in first call via a first network to communication in a second call via a second network. Claim 1 defines that the method of performing handover comprises establishing a second call between the mobile station and the first network via the second network. Lee does not disclose establishing a second call between the mobile station and the first network via the second network. Instead, Lee only discloses establishing a traffic channel between a subscriber unit and a base station of a second cellular network (see e.g. column 15, lines 16 to 51). This traffic channel is set up specifically for intersystem handover and supports the same call as originally existed, not a "second" call as is defined and claimed by Applicant. Since in Lee the call is not a different call from the original call, the second network must be capable of supporting intersystem handover connections. Lee, in column 8, lines 29-58, only discusses a "second inter-system" call, that allows an "inter-system soft handoff to occur." In contrast, in Applicant's invention, by establishing a second call between the first network and the mobile station via the second network, embodiments of the present invention enable calls to be handed over to networks that are capable of supporting new calls but are not capable of supporting specific intersystem handover connections. Therefore, claim 1 is not anticipated by Lee at least because Lee does not disclose or suggest the step of establishing a second call between the mobile station and the first network via the second network.

Furthermore, in Lee, both the first and second cellular systems are CDMA systems. For the method of Lee to work, it is necessary for both the first and second systems to support inter-system handover. The method of Lee would not work in a system where one of the networks is e.g. an old network that does not support inter-system handover. Lee does not consider the problems of handing over a call from a "new" network to an "existing" network. Therefore, Lee cannot address the problem addressed by Applicant's invention. Lee also does not disclose that handover is achieved by establishing a new logical call between the mobile station and the first network via the second network. Therefore, Lee does not suggest a method for performing handover of a mobile station communicating in first call via a first network to communication in a second call via a second network comprising the step of establishing a second call between the first network and the mobile station via the second network as recited in claim 1.

3. New claims 16, 22 and 30 define a method for performing handover, a mobile station and a network element, respectively according to a first embodiment of the invention. All three claims include the step of establishing a second call between the mobile station and the first network via the second network. Thus, at least for this reason as discussed above, claims 16, 22 and 30 are not anticipated by Lee.

New claims 35, 42 and 48 define a method for performing handover, a mobile station and a network element respectively according to a second embodiment of the invention. All three claims include a step either of transmitting data indicating an identification of the handover operation from the first network to the mobile station or of receiving data indicating an identification of the

handover operation at the mobile station. Claims 35, 42 and 48 contain similar features to claim 15, which the examiner has found to be allowable. Lee neither discloses nor suggests a method for performing handover comprising a step of transmitting from the network element to the mobile station data indicating an identification of the handover operation. Therefore, claims 35, 42 and 48 should be allowable.

4. Claims 3 and 5 are not unpatentable over Lee in view of Duran et al. ("Duran") under 35 U.S.C. §103(a), at least in view of their respective dependency on claim 1.

5. Claim 9 is not unpatentable over Lee in view of Byrne et al. under 35 U.S.C. §103(a) at least by reason of its dependency on claim 1.

6. Claim 10 is not unpatentable over Lee in view of Fernandez et al. under 35 U.S.C. §103(a) at least by reason of its respective dependency.

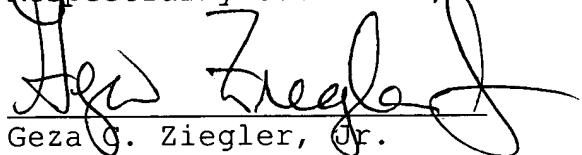
7. Claim 11 is not unpatentable over Lee in view of Menich et al. under 35 U.S.C. §103(a) at least in view of its dependency.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

A check in the amount of \$3,370 is enclosed for the additional claims fee (37 extra, 7 independent) and a one-month extension of time. The Commissioner is hereby authorized to charge payment

for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,



Geza J. Ziegler, Jr.
Reg. No. 44,004

29 August 2005

Date

Perman & Green, LLP
425 Post Road
Fairfield, CT 06824
(203) 259-1800 Ext. 134
Customer No.: 2512

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date indicated below as first class mail in an envelope addressed to MAIL STOP AMENDMENT, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date: August 29, 2005

Signature: Meagan Bayle
Person Making Deposit